

## **REMARKS**

### **I. STATUS OF THE CLAIMS**

Claims 1-3 and 6-9 are currently pending in the subject patent application. By the present amendment, independent claims 1-3 and 6 have been amended and claims 4, 5 and 10-15 have been cancelled without prejudice. It is submitted that no new matter has been added to the subject application.

### **II. CLAIM OBJECTIONS**

Since claim 4 has been cancelled without prejudice, the outstanding objection to claim 4 is now moot.

### **III. 35 USC §112 REJECTION**

Claim 1 stands rejected under 35 USC §112, second paragraph, as being indefinite. In particular, the Examiner stated "It is unclear whether the mailpiece is fed again in inverted orientation with respect to the previous orientation after printing the first set of marking by the print module so that the second set of marking can be inverted and printed by the inverted print module. For the examining purposes, Examiner reads the claims as 'prints a first or a second set of one or more markings onto the mailpiece.'"

By the present amendment, remaining independent claims 1 and 6 have been amended to positively recite that a mailpiece is printed with a first set of markings while in a first orientation and with a second set of inverted markings on the same mailpiece, which mailpiece is now is "disposed in a second orientation which is inverted about 180 degrees with respect to the first orientation." Thus, in answer to the Examiner's question: both a first and second set of markings are printed on a mailpiece.

In view of the aforesaid amendment to claims 1 and 6, it is respectfully submitted the subject 35 USC §112 rejection has been overcome and removal thereof is warranted.

#### IV. CLAIM REJECTIONS

- a. Claims 1, 3-6, 9-13 and 15 stand rejected under 35 USC §102(e) in view of US Patent No. 6,624,902 to Yoshikawa (the '902 patent); and
- b. Claims 2, 7, 8 and 14 stand rejected under 35 USC §103 over the '902 patent in view of US Patent No. 5,932,139 to Oshima (the '139 patent).

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With regards to claims 4-5 and 10-15, since they have each been cancelled without prejudice, the aforesaid rejection to each is now moot.

With regards to the remaining pending claims, both independent claims 1 and 6 have been amended to recite that a mailpiece is printed with a first set of markings while in a first mailpiece orientation and with a second set of inverted markings when the mailpiece is "disposed in a second orientation which is inverted about 180 degrees with respect to the first orientation." In other words, a mailpiece is processed in a first orientation for receiving a first set of markings and is then processed in a second orientation for receiving a second set of markings whereby the second orientation and set of markings is inverted "about 180 degrees" relative to the first orientation and set of markings.

With regards to the '902 patent, it explicitly teaches of either 1) printing an image in a "normal" orientation on a paper article designated as being normally feed or 2) printing an image in an "inverted" orientation on a paper article that was designated as being feed in a "reverse" orientation. More specifically, when the type of paper article is identified to controller 402 of a printing apparatus 302 by a user, the controller 402 provides notice to the user as to the input orientation (i.e., reverse or normal) of the identified paper article in printing apparatus 302 and a determination is made as to whether normal or inverted printing is to be performed on the paper article based upon its determined feed orientation into printing apparatus 302.

In significant contrast to the present claimed invention of claims 1 and 6, only a single printing (either in normal or inverted orientation) is performed on a paper article in the '902 patent (see Fig. 6 of the '902 patent). That is, the '902 patent provides no teaching or suggestion for printing on a mailpiece a first set of markings while the mailpiece is in a first orientation and a second set of inverted markings on the same

mailpiece when the mailpiece is "disposed in a second orientation which is inverted about 180 degrees with respect to the first orientation." Therefore, independent claims 1 and 6, along with their respective depending claims 2-3 and 7-9, are patentably distinct from the '902 patent.

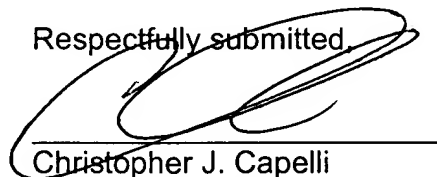
With regards to the '139 patent, it was cited by the Examiner for its teachings relating to scanning and OCR operations. Thus, the '139 patent does not overcome the above-noted deficiencies of the '902 patent. Hence, the pending claims of the present invention (i.e., 1-3 and 6-9) are likewise patentably distinct from the '139 patent, taken either alone or in combination with the '902 patent.

Therefore, it is respectfully submitted that removal of the subject USC §§102 and 103 rejections is warranted.

**V. CONCLUSION**

In view of the foregoing remarks, it is respectfully submitted that pending claims 1-3 and 6-9 are in condition for allowance and favorable action thereon is requested. If the Examiner should have any questions, he is kindly urged to contact the undersigned attorney.

Respectfully submitted,



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